

**COLLUM**

**Serial No.: 09/296,676**

~~23.~~ The anti-theft device according to claim 11, wherein the electronic apparatus is a consumer electronic device.

~~24.~~ The anti-theft device as claimed in claim 11, wherein the power blocking circuit is included within a packaged integrated circuit chip including other circuitry used by utilization circuitry of the electronic apparatus.

~~25.~~ The anti-theft device as claimed in claim 11, wherein the communication unit further comprises a programmable timer for periodically waking up the communication unit from an idle mode to activate the receiver to receive the signal transmitted from the interrogator.--

### REMARKS

Reconsideration and allowance of the subject patent application are respectfully requested.

The specification has been amended to correct a minor informality and to update the status of the patent application mentioned on page 8 of the specification. Entry of these amendments is respectfully requested.

Claims 1-10 were rejected under 35 U.S.C. Section 103(a) as allegedly being unpatentable over Heinrich *et al.* (U.S. Patent No. 5,874,902) in view of Mansell *et al.* (U.S. Patent No. 5,223,844). While not acquiescing in this rejection, claims 1, 5, 6, 8 and

10 are amended. As such, the applied art is discussed with reference to the amended claims.

Heinrich *et al.* discloses a radio frequency tag that is attached to “a critical part” of an external electronic circuit. The tag receives signals from an external base station when the tag is “presented” to the base station. The signals change data in the tag memory that causes the enable/disable tag circuit to control the critical part to enable and disable the electric circuit. Heinrich *et al.* does not disclose or suggest a remote intelligent communication (RIC) unit contained within a casing of the electronic apparatus. Indeed, the electronic circuit of Heinrich *et al.* is described as being “external” to the tag. In addition, as noted in the office action, Heinrich *et al.* does not disclose structure that enables tracking of the electronic apparatus. Heinrich *et al.* also does not disclose that the tag makes a determination as to whether a signal received from a base station is intended for the tag.

Mansell *et al.* is applied in the office action as allegedly disclosing an anti-theft device operable with an apparatus having a remote intelligent communication unit with structure that enables tracking of the apparatus for the purpose of locating lost or stolen apparatus. It is further alleged that it would have been obvious to incorporate tracking in Heinrich *et al.* because “Heinrich *et al.* suggests the remote intelligent communication unit that enables receiving disable signal from an interrogator and Mansell further teaches the remote intelligent communication unit having structure that enables tracking of the apparatus for the purpose of locating the lost or stolen apparatus.”

Applicant traverses the reasons stated in the office action for combining Heinrich *et al.* and Mansell *et al.* In particular, the office action identifies one aspect of the claimed subject matter as allegedly being present in Heinrich *et al.*, identifies another aspect of the claimed subject matter as allegedly being present in Mansell *et al.* and then concludes that the claimed invention therefore would have been obvious. However, obviousness is not established merely by identifying individual parts of an invention in the prior art. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d 1635, 1637 (Fed.Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed.Cir. 1984). No such motivation, suggestion or teaching is cited in the office action.

Mansell *et al.* discloses tracking in the context of locating a car, but does not teach or suggest tracking the location of an electronic apparatus. Tracking of an electronic apparatus is also not disclosed or suggested in Heinrich *et al.* who provide a system in which electronic circuits are non-functioning until properly "checked out." The only suggestion of tracking an electronic apparatus is found in Applicant's disclosure.

However, use of a suggestion in Applicant's disclosure in an obviousness determination is impermissible. "To imbue one of ordinary skill in the art with knowledge of the invention, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that

which only the inventor taught is used against its teacher." *W.L. Gore & Assoc. v. Garlock, Inc.*, 220 USPQ 303, 312-12 (Fed. Cir. 1983).

In short, the anti-theft devices and methods of claims 1-10 would not have been rendered obvious by a reference such as Heinrich *et al.* showing a tag attached to a critical part of an external circuit which receives signals when "presented" to a base station and a reference such as Mansell *et al.* which discloses a system for tracking an automobile.

New claims 11-25 are added for the Examiner's consideration. The subject matter of these new claims is fully supported by the original disclosure and no new matter is added. Applicant submits that the applied art does not teach or suggest an anti-theft device for shutting off an operable electronic apparatus subsequent to the electronic apparatus being stolen from its owner, wherein the anti-theft device comprises, among other things, a communication unit incorporated within the casing of the electronic apparatus which produces a shut-off signal in response to a shut-off command transmitted from a remotely located interrogator and wherein the shut-off signal is supplied to a power blocking circuit for placing the electronic apparatus in a shut-off state by blocking the flow of electricity from a power source of the electronic device.

Applicant submits that the pending claims are in condition for allowance, and action to that end is earnestly solicited.

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If any issues remain to be resolved, the Examiner is urged to contact the attorney  
for Applicant at the telephone number listed below.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

A handwritten signature in cursive script, appearing to read "Michael J. Shea", written over a horizontal line.

Michael J. Shea  
Registration No. 34,725

1100 North Glebe Road, 8<sup>th</sup> Floor  
Arlington, Virginia 22201-4714  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100

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**Version marked to show changes made**

**IN THE SPECIFICATION**

The paragraph beginning on page 8, line 18 has been amended as follows:

Turning now to FIGURE 2, an anti-theft device according to a preferred embodiment of the present invention may include a remote intelligent communication (RIC) unit 9 and an input device 11 contained within a conventional electronic device 13, such as a portable stereo. Briefly, the RIC 9 may be an integrated circuit with built in radio, processor, and memory circuits. The RIC unit 9 preferably includes a transceiver 91, a microcontroller 93, a memory device 95, and a digital serial I/O port 97. The RIC unit 9 may be provided on a single CMOS chip and may include additional features such as a clock recovery system and a spread spectrum processor. The transceiver 91 may include, for example, a modulated back scatter transmitter. Of course, separate receivers and transmitters could be provided. An appropriate RIC unit is commercially available from [the] Micron Communications, Inc. of Idaho through its MicroStamp™ product line. Accordingly, the details of the structure need not be further described. Additionally, further details of appropriate enabling circuitry for implementing the transceiver, processor and memory portions of Figure 2 are disclosed in [co-pending,] commonly owned U.S. [application Serial Number 08/705,043 filed August 29, 1996 (Docket Number 96-0327US)] Patent No. 6,130,602, issued October 10, 2000, which is hereby incorporated by reference in its entirety.

The paragraph beginning on page 10, line 12 has been amended as follows:

In a preferred implementation, once the device is disabled, the microcontroller is programmed to maintain the transistor 21 in an OFF state until the device is reset by an authorized repair center or the rightful owner of the goods. For example, the microcontroller 93 can maintain the transistor 21 in the OFF state until an appropriate security code or other information that is available to the rightful owner (such as purchase date, location, etc.) is entered by way of input device 11. The microcontroller compares the input data [date] to stored data to verify the information is being input by authorized personnel. If desired, provisions could also be made to reset the system remotely by transmission of a reset signal that is received by the RIC unit 9 through transceiver 91. Any such remote reset signal also should include security information such as a PIN number. Security in remote resetting can be increased by using digital transmissions and/or by encrypting the information contained in the broadcast reset signal.

### **IN THE CLAIMS**

Claims 1, 5, 6, 8 and 10 have been amended as follows:

1. (Amended) An anti-theft device operable with an electronic apparatus, the device comprising:

a remote intelligent communication (RIC) unit contained within a casing of the electronic apparatus and including structure that enables tracking of the electronic apparatus, said RIC unit operable to receive a [disable] signal transmitted from an interrogator, to determine whether the signal is intended for the anti-theft device and

whether the signal includes a shut-off command and, if so, to produce a shut-off [an output] signal in response; and

a shut-off unit coupled with a power source of the electronic apparatus, said shut-off unit in a shut-off state preventing a flow of electricity via the power source in accordance with said shut-off signal.

5. (Amended) The anti-theft device as claimed in claim 1, wherein said shut-off unit comprises a fusible link.

6. (Amended) A method of operating an anti-theft device in cooperation with an electronic apparatus, the anti-theft device including a remote intelligent communication (RIC) unit contained within a casing of said electronic apparatus and that receives a [shut-off] signal broadcast from an interrogator, determines whether the signal is intended for the anti-theft device and whether the signal includes a shut-off command and, if so, produces a shut-off signal in response, and a shut-off unit comprised of components of the RIC unit and coupled with a power source of the electronic apparatus, the method comprising:

(a) tracking the electronic apparatus with the remote intelligent communication (RIC) unit; and

(b) preventing with the shut-off unit a flow of electricity via the power source in accordance with the shut-off signal.



8. (Amended) A method according to claim 6, wherein the anti-theft device further includes a coded reset device, the method further comprising maintaining the shut-off unit in a shut-off state until a predetermined code is input to the reset device [deactivate assembly].

10. (Amended) The method according to claim 6, wherein the shut-off unit further includes a fusible link.